

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:  
Eugenio Cruz GARCIA

Customer No. 30827

Application No. 10/678,219

Confirmation No. 1575

Filed: October 6, 2003

Art Unit: 3635

For: FLOORING SYSTEM HAVING  
MICROBEVELS

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Examiner: Chi Q. Nguyen

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**COMMUNICATION WITH TERMINAL DISCLAIMER**

Sir:

In conjunction with filing a Terminal Disclaimer in the above captioned patent application, the Applicants submit the following remarks for the record.

**REMARKS**

At the outset, the Examiner is thanked for the telephone conversation on April 19, 2010 indicating that the prior asserted Obviousness-Type double patenting rejection of the prior office action would be maintained. That provisional, non-statutory, Obviousness-Type double patenting rejection rejected claims 22-47 of the present application over claims 1-49 of co-owned and co-pending Patent Application No. 10/374,751 ("the '751 Application").

As the Applicants have set forth in the past responses to this rejection, Applicants respectfully disagree with the basis for the rejection. Applicants maintain that claims 22-47 of the present application are patentably distinct over claims 1-49 of the '751 Application for at least the reasons set forth in the record. Moreover, the claims of the '751 patent have been amended and are

still open for amendment. Therefore, Applicants believe that the requirement for the filing of a Terminal Disclaimer is not ripe.

The doctrine of Obviousness-Type double patenting, as created by the courts, was intended to prevent a patent owner from extending the life of a patent by benefitting from a second patent having a later expiration date, but claiming only obvious (or patentably indistinct) variations of the previously patented claims. See, e.g., Amgen, Inc. v. F. Hoffman-La Roche, Ltd., 580 F.3d 1340, 1352 (Fed. Cir. 2009). In view of the above and to expedite prosecution of this case, Applicants hereby file a Terminal Disclaimer, rendering the rejection moot for the purposes outlined by the courts.

In view of the foregoing Remarks, Applicants believe the application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Dated: April 22, 2010

Respectfully submitted,  
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